



**UNITED STATES DEPARTMENT OF COMMERCE  
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/957,709	10/24/97	HOGREFE	H 1486/41363CP

HM31/1005  
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EXAMINER
HOUTTEMAN, S

ART UNIT	PAPER NUMBER
1634	

DATE MAILED: 10/05/98

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.  
08/957,709

Applicant(s)  
Hogrefe et al.

Examiner  
Scott W. Houtteman

Group Art Unit  
1634



☐ Responsive to communication(s) filed on \_\_\_\_\_.

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 30 days month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-94 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☐ Claim(s) \_\_\_\_\_ is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☒ Claims 1-94 are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

1. Restriction to one of the following inventions is required under 35 U.S.C. § 121:
  - I. Claims 1-23, 28-39, 45, 46, 59-66, 77-80, 85, 87-92, drawn to compositions comprising polymerase enhancing activity, mixtures, kits, complexes and proteins, classified in class 530, subclass 350.
  - II. Claims 24-27, 58, 67, 68, 84, drawn to DNA and DNA replication kits, classified in class 536, subclass 23.2.
  - III. Claims 40-44, 69-74, drawn to Methods of enhancing polymerase, classified in class 435, subclass 4.
  - IV. Claim 47, drawn to a method of purification, classified in class 210, subclass 656.
  - V. Claims 48-57, 75 and 76, drawn to methods of detection of polymerase enhancing activity, classified in class 435, subclass 6.
  - VI. Claims 81-83 and 86, drawn to methods of protein production, classified in class 435, subclass 69.2.
  - VII. Claims 93 and 94, drawn to computer readable sequences and methods of computer screening, classified in class 706, subclass 932.
2. The inventions are distinct, each from the other for the following reasons: Inventions IV and VI are both related to invention I as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In this case the product can be made by the two materially different processes, IV and VI.

Inventions I and III are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In this case the product can be used in a protein purification process as well as a method of enhancing polymerase.

The nucleic acid of group II and the proteins of group I are chemically different with different structures, functions, and properties and are therefore distinct. Also, given the nucleic acid, one of ordinary skill in the art could not reasonably expect to come up with the active native protein. Recombinant proteins do not often fold up into native conformation. In addition, the protein can be obtained by a method other than recombinant DNA technology, for example, by purification from natural sources.

The methods of groups I, III, IV, IV and VII are distinct. They have different reagents, different steps and yield different products.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Papers relating to this application may be submitted to Technology Center 1600 by facsimile transmission. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The Technology Center 1600 Fax numbers are (703) 305-3014 and 308-4242.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Scott Houtteman whose telephone number is (703) 308-3885. The examiner can normally be reached on Tuesday-Friday from 8:30 AM - 5:00 PM. The examiner can also be reached on alternate Mondays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, W. Gary Jones, can be reached at (703) 308-1152.

Any inquiry of a general nature or relating to the status of this application should be directed to the Technology Center receptionist whose telephone number is (703) 308-0196.

Scott Houtteman  
October 2, 1998



SCOTT W. HOUTTEMAN  
PRIMARY EXAMINER